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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,038	06/23/2003	Kathiravan Sengodan	BEAS-01351US4	9529
23910	7590	11/02/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			TECKLU, ISAAC TUKU	
			ART UNIT	PAPER NUMBER
			2192	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,038

Applicant(s)

SENGODAN, KATHIRAVAN

Examiner

Isaac T. Tecklu

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/24/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed on 06/23/2003.
2. Claims 1-18 have been examined.

Oath/Declaration

3. The office acknowledges receipt of a properly signed oath/declaration filed on 06/23/2003.

Claim Objections

4. Claims 1-8 and 10-17 are objected to because of the following informalities:

Claims 1, 7, 8, 10, 13, 16, and 17, recite acronym "JMS", such acronym should be spelled out once in the claims as its intended meaning and utility will be changed over time. Appropriate correction is required.

Claims 2, 5, 6, 11, 14 and 15, recite acronym "JMSML", such acronym should be spelled out once in the claims as its intended meaning and utility will be changed over time. Appropriate correction is required.

Claims 3-6 and 12-14, recite acronym "XML", such acronym should be spelled out once in the claims as its intended meaning and utility will be changed over time. Appropriate correction is required.

Claims 7-8 and 16-17, recite acronym "JMX", such acronym should be spelled out once in the claims as its intended meaning and utility will be changed over time. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 7-8, 10 and 16-17 are rejected as failing to define the invention in the manner required by 35 U.S.C 112, second paragraph.

Claims 1, 7, 8, 10, 13, 16, and 17 contain the trademark name JMS. Where a trademark or trade name is used in a claim as limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe JMS and, accordingly, the identification/description is indefinite.

Claims 7-8 and 16-17 contain the trademark name JMX. Where a trademark or trade name is used in a claim as limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe JMX and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-18 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory matter.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a “useful, concrete, and tangible result” be accomplished. An “abstract idea” when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a “useful, concrete and tangible result”.

Specifically, claims 1 and 10 recite a system/method comprising an integrated development environment that includes a graphical user interface that executes on a client machine and allows a user to edit and modify markup language programs that access JMS interfaces. As a whole, the claims lack teaching as to what is being transformed or what action is taken as a result of the editing and modifying markup language programs that access the JMS interfaces. That is, comprising solely of steps of editing and modifying markup language programs, the claims do not enable the realization of a concrete result because what result being inferred from editing and modifying markup language remains a concept or a non-tangible representation that cannot materialize itself out and into a tangible outcome without teaching from the claim for conveying that an explicit action is executed to yield a result based upon such said editing and modifying markup language. Absent any tangible result, the claimed invention thus fails to fulfill the Practical Test Application; and is rejected for leading to a non-statutory subject matter.

Claims 2-9 and 11-18 are rejected for failing to cure the deficiencies of the above rejected non-statutory claims 1 and 10 above.

Double Patenting

Art Unit: 2192

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1898); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-3, 5, 7-12, 14 and 16-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims copending Application No. 10/601898 (hereinafter ‘898’)

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following observations.

Following are but a few examples as to how the certain claims from the instant invention and from the above copending application are conflicting with each other.

As per claims 1 and 10, copending ‘898’ claim 1 also recites a system comprising: a web application including a user interface ... converts the markup language components into one of

Art Unit: 2192

JMS or JMX system operations. Even though '898' claim recites converting the markup language into one of JMS or JMX system operations whereas the instant claimed counterparts only recite editing and modifying markup language programs, one skilled in the art would recognize that converting the markup language into one of JMS or JMX system operations constructs are derived from the very same defined constructs editing and modifying markup language programs recited in the instant and the copending claims, such that it is reasonable to construct that the '898' markup language constructs read on the defined constructs of the instant claim. This is an obviousness-type of anticipatory double patenting because the recited subject matter is not identical in language, the species claimed subject matter reads on, in an anticipatory matter—the subject matter not patentably distinct – the subject matter of the instant claims.

As per claims 2 and 11, copending '898' claim 8 also recites the markup language to be JMS markup language. The reciting of JMS in the '898' claims has been deemed as not distinct from the JMSML of the instant claims from the above rationale.

As per claims 3 and 12, copending '898' claim 9 also recites programs as XML code. The reciting of XML file in the '898' claims has been deemed as not distinct from the XML code of the instant claims from the above rationale.

As per claims 5 and 14, copending '898' claims 8 and 9 also recite a user to enter JMSML program as XML code. The reciting of JMS and XML in the '898' claims has been deemed as not distinct from the JMS and XML of the instant claims from the above rationale.

As per claims 7 and 16, copending '898' claim 7 also recites the parser and command processor. The reciting of parser and command processor in the '898' claims has been deemed as not distinct from the parser of the instant claims from the above rationale.

As per claims 8 and 17, copending '898' claim 7 also recites parser and command processor ... generates corresponding JMS or JMX commands. The reciting of JMS or JMX commands in the '898' claims has been deemed as not distinct from the generating command of the instant claims from the above rationale.

As per claims 9 and 18, copending '898' claim 6 also recites communicating markup language components to remote server via a wide area network or the Internet.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Najmi (US 6,753,889 B1).

As per claim 1, Najmi discloses a system including an integrated development environment for use with a JMS mark-up language (e.g. Fig. 2 and related text), comprising:
an integrated development environment that includes a graphical user interface that executes on a client machine (e.g. Fig. 2, element 204-1 through 204-3 and related text) and allows a user to edit and modify markup language programs that access JMS interfaces (in column 3, lines 60-68 "... modify the JMS message ...").

As per claim 2, Najmi discloses the system of claim 1 wherein the markup language is JMSML (in column 3, lines 60-68 "... JMS message ...").

As per claim 3, Najmi discloses the system of claim 1 wherein the graphical user interface includes a source editor that allows a user to enter programs as XML code (in column 8, lines 35-40 "... in the form of XML ...").

As per claim 4, Najmi discloses the system of claim 1 wherein the graphical user interface includes a design editor and a set of toolbars that allow a user to generate XML source

Art Unit: 2192

code by visually assembling JMS commands (in column 10 , lines 5-10 "... XML upon delivery rule ...").

As per claim 5, Najmi discloses the system of claim 2 wherein the graphical user interface includes a source editor that allows a user to enter JMSML programs as XML code (in column 8, lines 35-40 "... in the form of XML ...").

As per claim 6, Najmi discloses the system of claim 2 wherein the graphical user interface includes a design editor and a set of toolbars that allow a user to generate JMSML XML source code by visually assembling JMSML commands (e.g. Fig. 7B, element 728 and related text).

As per claim 7, Najmi discloses the system of claim 1 further comprising a parser that parses said program and communicates said markup language components to a command processor (in column 5, lines 15-20 "... parses ..."); and, a command processor that converts the markup language components into one of JMS or JMX system operations (in column 8, lines 40-45 "... converting XML ... Java ").

As per claim 8, Najmi discloses the system of claim 7 wherein said parser and said command processor comprise an engine that parses markup language components and source files and generates corresponding JMS or JMX commands (in column 8, lines 40-45 "... converting XML ... Java ").

As per claim 9, Najmi discloses the system of claim 1 wherein said integrated development environment is used to communicate said markup language components to said remote server via a wide area network or the Internet (e.g. Fig. 1 and related text).

As per claim 10, this is the method version of the claimed system discussed above (Claim 1), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Najmi.

As per claim 11, this is the method version of the claimed system discussed above (Claim 2), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Najmi.

As per claim 12, this is the method version of the claimed system discussed above (Claim 3), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Najmi.

As per claim 13, this is the method version of the claimed system discussed above (Claim 4), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Najmi.

As per claim 14, this is the method version of the claimed system discussed above (Claim 5), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Najmi.

As per claim 15, this is the method version of the claimed system discussed above (Claim 6), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Najmi.

As per claim 16, this is the method version of the claimed system discussed above (Claim 7), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Najmi.

As per claim 17, this is the method version of the claimed system discussed above (Claim 8), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Najmi.

As per claim 18, this is the method version of the claimed system discussed above (Claim 9), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Najmi.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac T. Tecklu whose telephone number is (571) 272-7957. The examiner can normally be reached on M-TH 9:300A - 8:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Isaac Tecklu
Art Unit 2192



TUAN DAM
SUPERVISORY PATENT EXAMINER